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In the Supreme Court of the United States

OCTOBER TERM, A. D. 1964.

No. 826.

ROBERT C. SWITZER and RICHARD A. WARD,
Cross-Petitioners—Respondents,

vs.

LOY W. SOCKMAN and ELLIOTT W. BRADY,
Cross-Respondents—Petitioners.

CROSS-PETITION FOR WRIT OF CERTIORARI
To the United States Court of Customs and Patent Appeals.

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CROSS-PETITION FOR WRIT OF CERTIORARI To the United States Court of Customs and Patent Appeals.

To the Honorable Earl Warren, Chief Justice of the United States, and the Associate Justices of the Supreme Court of the United States:

CROSS-PETITION.

Cross-Petitioners—Respondents cross-petition for a writ of Certiorari to the Court of Customs and Patent Appeals to review and correct the disposition of "Question 2" in that Court's judgment and decision in *Switzer et al. v. Sockman et al.*

OPINION BELOW.

The opinion of the Court below, for which review in part is sought, is reported at 333 F. 2d 935; 51 CCPA ...; 142 USPQ 226.

JURISDICTION.

The judgment sought to be reviewed was dated and entered on July 16, 1964.

A timely petition for rehearing of said judgment and its accompanying decision was denied by an order dated and entered on November 5, 1964.

This Court is vested under the United States Code, Title 28, Section 1256, with jurisdiction to review, by Writ of Certiorari, cases in the Court of Customs and Patent Appeals. This cross-petition is filed within ninety days from the date of denial of rehearing by said Court below, pursuant to 28 USC 2101 (c).

QUESTIONS PRESENTED.

1. May an appellee, before the Court of Customs and Patent Appeals, first raise points, as a cross-appellant, in his brief on appeal to that Court and without first filing his reasons for cross-appeal in the Patent Office, pursuant to 35 USC 142?

2. Is the Court of Customs and Patent Appeals, pursuant to 35 USC 144, empowered to entertain or decide points not set forth in any reasons of appeal filed in the Patent Office pursuant to 35 USC 142?

3. May the Court of Customs and Patent Appeals entertain and review specific factual issues which have been previously considered and decided by the United States District Court for the District of Columbia in a suit brought under 35 USC 145 and in which the Patent Office, through the Commissioner of Patents in his official capacity, was the unsuccessful defendant?

4. May the Court of Customs and Patent Appeals direct the Patent Office Board of Patent Interferences to review issues previously adjudicated by the United States District Court for the District of Columbia in a suit brought under 35 USC 145 and in which the Patent Office, through the Commissioner of Patents in his official capacity, was the unsuccessful defendant?

5. May the Commissioner of Patents, pursuant to 35 USC 24, refuse to issue orders, in the nature of orders under the Federal Rules of Civil Procedure, respecting testimony taken in contested cases in the Patent Office?

6. May the Board of Patent Interferences refuse to apply Patent Office Rule 201(c) to compel disclosure of the real parties in interest behind one party to a patent interference whereby another party to such interference is deprived of review under 35 USC 146 for lack of knowledge of the District Court having venue for such review?

THE CONSTITUTIONAL PROVISION, STATUTES AND REGULATIONS INVOLVED.

This cross-petition involves the following Constitutional provision, Federal statutes, a Federal Rule of Civil Procedure, and a Patent Office rule. This material is set forth verbatim in the attached appendix to this cross-petition at pages indicated thus [C-P ap. __] or in petitioners' petition, No. 715, at pages indicated thus [P. __]. It is requested that said petition be deemed, for this purpose, an appendix to this cross-petition:

Constitution of the United States, Article 1, Clause 8 [P. 3].

Title 28, United States Code:

Section 1242 [P. 5]
Section 1256 [P. 5]

Title 35, United States Code:

Section 23 [C-P ap. 16]
Section 24 [C-P ap. 16]
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Section 145 [C-P ap. 18]
Section 146 [C-P ap. 18].

Federal Rule of Civil Procedure 30(b) [C-P ap. 20].

Title 37, Part 1, Code of Federal Regulations:

Section 1.201(c) [C-P ap. 20. This is Patent Office Rule 201(c), most conveniently published in the appendix to 35 U. S. Code Annotated, Vol. 2, at pages 706-7].

STATEMENT OF CASE.

Initial Patent Office Proceedings.

On January 26, 1955 cross-petitioners filed a patent application containing claims copied from petitioners' patent, issued January 26, 1954. Cross-petitioners' 1955 patent application included substantially the entire disclosure of their then still pending application filed in 1945 and, under 35 USC 120, the 1955 application is entitled to the benefit of the 1945 filing date for the common subject matter of the two applications.

In order to ascertain whether petitioners or cross-petitioners were the first and original inventors of the subject matter of the claims copied from petitioners' 1954 patent, the Patent Office, promptly and pursuant to 35 USC 135, declared an interference between cross-petitioners' 1955 patent application and petitioners' 1954 patent. In such interference proceedings, petitioners did not allege that they had performed any acts which could establish that they invented the subject matter of the patent claims prior to cross-petitioners' 1945 application. Instead, petitioners moved to dissolve the interference on the ground that cross-petitioners' 1945 application did not disclose the subject matter of the patent claims in interference and, thus, cross-petitioners had no right to copy said claims in their 1955 application. A Primary Examiner in the Patent Office granted petitioners' motion on this ground and dissolved the interference. Cross-petitioners lost their appeal to the Patent Office Board of Appeals from decisions of the Primary Examiner and sought review of such Patent Office decisions by a suit under 35 USC 145, filed in the United States District Court for the District of Columbia against the Commissioner of Patents in his official capacity.

District Court Adjudication.

In 1960, in *Switzer et al. v. Watson, Commissioner of Patents,* 183 F. Supp. 467, Judge Giles Rich, of the Court of Customs and Patent Appeals, sitting by designation, overruled the Patent Office decisions; based on a thorough review of the evidence and subject matter of petitioners' patent and cross-petitioners' 1945 and 1955 patent applications, the District Court held that cross-petitioners' 1945 parent application did, in fact, disclose the subject matter of the claims copied from petitioners' 1954 patent and, thus, that "* * * it seems clear to me that plaintiffs [cross-petitioners] have every right to copy these claims and to contest the right of Sockman et al. [petitioners] to them * * *." (183 F. Supp. 472-473; appendix to this cross-petition, p. 31.)

Patent Office Proceedings Subsequent to District Court Adjudication.

The interference between petitioners and cross-petitioners was thereupon redeclared in the Patent Office in conformity with the District Court's decision and decree. Petitioners, still not alleging inventorship of the subject matter of their claims prior to cross-petitioners' 1945 application, renewed their motion contending that cross-petitioners' 1945 application did not disclose the subject matter of petitioners' patented claims and, thus, that cross-petitioners had no right to copy them, the squarely contrary adjudication in *Switzer v. Watson* notwithstanding. Decision on petitioners' renewed motion was deferred until final hearing by the Board. Preliminary to such final hearing, the Patent Office set time for the parties to take testimony relevant to the issues of the interference. Cross-petitioners, relying upon 35 USC 24, moved for an order, in the nature of an order under Rule 30(b), Federal

Rules of Civil Procedure, directing petitioners to limit their testimony to matters other than the fact of whether cross-petitioners' 1945 application disclosed the subject matter of the claims in interference, the issue adjudicated in *Switzer v. Watson;* said motion was denied by the Patent Office, not on its merits, but on the ground that Federal Rules of Civil Procedure would not be applied to proceedings in the Patent Office. Petitioners were, thus, permitted to take extended depositions in California and South Carolina in an effort to show, by physical tests and expert testimony, that the adjudication in *Switzer v. Watson* was factually incorrect; cross-petitioners took rebuttal testimony in Philadelphia and Cleveland.

After a final interference hearing in 1962, a majority of the Board of Patent Interferences held that it could give no weight to the extensive testimony taken by the parties, the Patent Office and its tribunals being bound, under the doctrine of *Henning v. Hunt,* 223 F. 2d 926, 42 CCPA 1064, by the adjudication in *Switzer v. Watson* of precisely the same issue to which the additional interference testimony was directed. However, the majority of the Board, feeling that it was bound by the ruling of the Assistant Commissioner in the earlier 1962 decision of *Rubenstein v. Schmidt,* 133 USPQ 91, held that, by filing their application on the first anniversary of the grant of petitioners' patent, cross-petitioners had not filed in compliance with 35 USC 135 and, therefore, awarded priority to petitioners.

In moving for rehearing of the decision of the Board of Patent Interferences, cross-petitioners also sought, under Patent Office Rule 201(c), an order directing petitioners to disclose all parties having any right, title, and interest in petitioners' patent in interference. Such order was refused in the Board's denial of rehearing.

Appeal to the Court of Customs and Patent Appeals.

Cross-petitioners should have had a choice of statutory reviews of the Patent Interference Board's decisions, either by an appeal, under 35 USC 141, to the Court of Customs and Patent Appeals (which has no rule of its own regarding the computation of a statutorily prescribed period of time) or by a suit, under 35 USC 146, against the real parties in interest in petitioners' patent in an appropriate District Court of the United States (which District Court would not only be governed by Rule 6(a), Federal Rules of Civil Procedure, in regard to the interpretation of 35 USC 135, but would also have the power, in its discretion, to enjoin infringement by the parties found not to be entitled to the claims in dispute). The failure of the Patent Interference Board to compel petitioners to disclose their real parties in interest, however, denied cross-petitioners of knowledge of which District Court of the United States would be vested with venue as prescribed in 35 USC 146 and, thereby, left cross-petitioners with no choice but to appeal to the Court of Customs and Patent Appeals (whose jurisdiction, vested by 28 USC 1542, is not limited by geographical venue).

Cross-petitioners, therefore, duly pursuant to 35 USC 142, gave notice to the Commissioner of Patents of their appeal to the Court below, stating their reason for appeal in writing, as required by said statute. Cross-petitioners, in stating to the Commissioner their reason for appeal to the Court below,[1] in no way challenged or raised

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[1] Said reasons for appeal essentially challenged the correctness of the interpretation of 35 USC 135 as applied by the Board in following the Rubenstein decision and, under *Henning v. Hunt*, the power of the Patent Office, subsequent to *Switzer v. Watson*, to challenge the timeliness of filing cross-petitioners'

(Continued on following page)

a point as to the correctness of the Board's eventual decision to give no weight to the testimony taken by the parties subsequent to the decision in *Switzer v. Watson*, it having been cross-petitioners' consistent position that the one issue to which such testimony related had been adjudicated, which decision was, therefore, binding on the Patent Office as a party defendant thereto.

Petitioners neither elected, as was their option under 35 USC 141, to have cross-petitioners appeal to the Court below dismissed in favor of a suit pursuant to 35 USC 146, nor did petitioners cross-appeal to the Court below pursuant to 35 USC 142, or file with the Commissioner[2] any reasons for cross-appeal, as would also be required by 35 USC 142.

In the Court below, petitioners did not challenge the correctness of the Patent Interference Board's refusal to give any weight to testimony taken after the *Switzer v. Watson* decision or challenge its factual correctness until after cross-petitioners had filed their brief as appellants. But such challenges were made by petitioners in a brief responding to cross-petitioners' brief. Cross-petitioners moved to strike so much of petitioners' brief as went be-

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(Continued from preceding page)

application. (The compliance of cross-petitioners' application with all pertinent statutes respecting the filing thereof had been put in issue by the pleadings in *Switzer v. Watson* and the fact that cross-petitioners had filed their application on the first anniversary of the grant of petitioners' patent had been noted at the outset of the decision in *Switzer v. Watson*.)

[2] Petitioners did request the Commissioner of Patents to enlarge the record specified by cross-petitioners for transmittal to the Court below by adding many documents, including the full record of testimony taken subsequent to the decision in *Switzer v. Watson*. Cross-petitioners, on the ground that such expansion of the record (totaling 895 pages when printed) was in no way pertinent to points raised by any stated reason of appeal and would place an undue burden on cross-petitioners, protested without avail to the Patent Office and to the Court below.

yond a response as appellees; cross-petitioners' ground was that such extrapolation in an appellee's brief beyond any point of a reason for appeal stated to the Commissioner under 35 USC 142 amounted, *de facto,* to a fatally delayed cross-appeal, unsupported by any stated reasons of appeal filed under 35 USC 142 and, therefore, beyond the scope and power of the Court below to decide, such scope of decision being limited by the statute, 135 USC 144, requiring that a "* * * decision [of the Court below] shall be confined to the points set forth in the reasons of appeal." The Court denied cross-petitioners' motion but allowed them to file a reply brief to such matter, not covered in cross-petitioners' main brief.

In its decision of July 16, 1964, in "Question 1," the Court below disposed of all the points set forth in cross-petitioners' reasons for appeal by reversing the Board's refusal of a patent to cross-petitioners on the ground that it was not timely filed under 35 USC 135. However, in "Question 2" of its decision, the Court below reversed the decision of the majority of the Board to not weigh the testimony taken after *Switzer v. Watson* and remanded the case for a decision by a full Patent Office Board as to whether, in the light of testimony taken subsequent to *Switzer v. Watson,* the factual conclusion of that decision was correct and, thus, whether or not cross-petitioners' 1945 application did disclose the subject matter of the claims in issue.

REASONS FOR GRANTING WRIT.

This cross-petition for this Court to exercise its supervisory powers so that the Patent Statutes shall be followed to meet their Constitutional purposes raises many novel Federal questions—and ones which are unlikely to be decided unless and until this Court does so.

Thus, if the Court below, a special appellate court established to review decisions of three governmental agencies under 28 U. S. C. 1542, continues to exclude cross-appeals from the procedural limitation on the scope of its decisions[3] and decide points not raised before it as required by 35 U. S. C. 142 and 144, only this Court is vested with authority to restrain it.

Certainly the Court below has not been consistent in its dealing with the problems of a Federal bureau's need to follow, wholly apart from a question of *res adjudicata*, the conclusion of a Federal Court in an action in which the bureau was a party when precisely the same issue is re-raised after such decision in an administrative tribunal of that bureau. In its *Henning v. Hunt* decision, the Court below formerly inequivocably held that neither the Commissioner of Patents nor any tribunal of the Patent Office could function as an appellate court re-trying the same issues which a District Court, having reviewing authority over the Patent Office, had previously decided. Under the decision below, if the issue is re-raised by the same party who first raised it in the Patent Office but who did not elect to intervene as a named party in the District

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[3] The restiveness of the Court below under the statutory restriction on matters it may decide is revealed by the concurring opinions in *In re LePages, Inc.*, 312 F. 2d 455, to the effect that the procedural limitations of 35 U. S. C. 144 are vestigial encumbrances of archaic appellate procedures no longer applicable to the United States Courts of Appeal for the several Federal Circuits.

Court suit under 35 USC 145, the Patent Office may later function as though it were a sister court of the District Court for the District of Columbia.

The seed for the controversy which has been raging in the Patent Office since the 1960 adjudication in *Switzer v. Watson* of the basis for petitioners contesting cross-petitioners' patent application lies in the Commissioner's failure to issue an order in the nature of an order under Rule 30(b), Federal Rules of Civil Procedure, barring petitioners from taking testimony on that issue in the Patent Office and leaving petitioners to their remedies under 35 USC 146 in a Federal District Court. As pointed out in *Turchan v. Bailey Meter Co.* (D. C. Del., 1958), 167 F. Supp. 58, due to the difference in parties, the District Court trying such an action under 35 USC 146 is not bound by the decision of its sister court in the District of Columbia in a suit against the Commissioner of Patents under 35 USC 145. Even after the Patent Interference Board's decision, petitioners did not elect such review under 35 USC 146, which could have brought this controversy to a close, and cross-petitioners were blocked from doing so by the Board's failure to enforce Patent Office Rule 201(c). And the unexcused practices of the Commissioner of Patents in failing to provide parties to interferences with the protection contemplated by 35 USC 24 and in failing to follow its own rules so as to deprive a party of a manner of review contemplated by statute, having been tacitly condoned by the Court below, are certainly likely to continue unless this Court condemns them.

The real evil, however, of allowing a continuance of the several stultifications of the patent statutes, as exemplified by the foregoing statement of this case, lies in their cumulative effect and the consequent subversion of the Constitutional purpose of the present statutes to promote the useful arts.

The real matter of substantial public interest raised by this cross-petition is not so much that one patent application has been forced through so many obstacles by poor administrative judgment, disregard of express provisions of the patent statutes, and an instruction to an administrative bureau to disregard an adjudication to which it was a party—with the consequence that the end of a controversy that has been raging for a decade in the Patent Office is not yet in sight.[4] Nor, is it so much that the many industries which use or could use the inventions covered by the claims in controversy still do not know whether they will have to account to petitioners or cross-petitioners until the invention goes into the public domain. Nor does the substantial public interest in disposing of the questions raised by this cross-petition lie entirely in the fact that venture capital and energy, under the incentive of a patent containing the claims in controversy, has not been expended in promoting the progress of the art to which the claims relate but has, instead, had to be diverted to a protracted and still unended contest to determine the priority of inventorship of such subject matter.

Rather, it is submitted that the great public interest in resolving the questions raised by this cross-petition lies in the fact that the degree of the blight of delay on the promotion and progress of one art by departures from ex-

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[4] It is hardly to be expected that, after the further Patent Office proceedings directed by the Court below, the loser, having made its existing investments in patent proceedings, would fail to seek a further appellate review, whereas, if the Court below had contented itself with reversing the Patent Office Board on the only points sanctioned by 35 USC 144, the Commissioner would have had no excuse for not issuing cross-petitioners a patent as decreed in *Switzer v. Watson*—and the controversy between cross-petitioners and petitioners would lie only in a Federal District Court capable of entertaining an action for infringement—where the controversy should have been commenced promptly after the *Switzer v. Watson* decree disposed of the matter as far as the Patent Office should have been involved.

isting patent laws, as condoned or directed by the Court below, can arise, to unpredictable greater or lesser degrees, with respect to other arts as well—unless this Court compels strict compliance with existing patent statutes in the Patent Office and in a court charged with reviewing proceedings in the Patent Office.

The petition of the petitioners refers to an address of the Commissioner of Patents of June 8, 1964, 803 O. G. 895, as:

> "* * * indicative of the need of facilitating the determination of the substantive rights of rival inventors in common subject matter and the amendment of the rules of the Patent Office to accommodate that determination." (Petition for Writ of Certiorari, No. 715, p. 9.)

Even if the asserted need for new statutes and rules for promptly resolving patent interferences were not a legislative and administrative matter beyond the ambit of this Court's discretion, the actuality of such a need can hardly be accepted until, through this Court, the Court below and the Commissioner are directed to function and have functioned according to existing statutes. No criticisms, by way of suggestions for changes of statutes and rules conforming thereto, or otherwise, of the existing Federal patent system can be validly directed to the system, as such, until the Patent Office complies with existing statutes and rules and Courts entrusted with supervising such administration carry out their responsibilities according to statute. This cross-petition points out a clear default in such administration and responsibility.

Wherefore, cross-petitioners pray that a writ of certiorari issue under the seal of this Court directed to the United States Court of Customs and Patent Appeals sitting at Washington, in the District of Columbia, command-

ing said court to certify and send to this Court on a day to be designated a full and complete transcript of the record and all proceedings of the said Court of Customs and Patent Appeals had in the case Patent Appeal Docket No. 7128, Robert C. Switzer and Richard A. Ward v. Loy W. Sockman and Elliott W. Brady, Interference No. 87,474, to the end that this cause may be reviewed and determined by this Court; that the judgment therein of the said Court of Customs and Patent Appeals, in so far as said judgment directs or condones any proceeding in the Patent Office permitting petitioners to contest issues adjudicated in *Switzer v. Watson,* be reversed by this Court; and that cross-petitioners have such other and further relief as this Court may deem proper.

Respectfully submitted,

ALBERT L. ELY, JR.
Counsel for Cross-Petitioners.

APPENDIX A.

Statutes, a Rule of Federal Procedure, and a Patent Office rule involved in this case and not set forth verbatim at cited pages in petitioners' petition No. 715. Emphasis is supplied at the passages particularly pertinent to this cross-petition.

Title 35, United States Code:

CHAPTER 2—PROCEEDINGS IN THE PATENT OFFICE

§ 23. Testimony in Patent Office cases

The Commissioner may establish rules for taking affidavits and *depositions required in cases in the Patent Office.* Any officer authorized by law to take depositions to be used in the courts of the United States, or of the State where he resides, may take such affidavits and depositions.

§ 24. Subpoenas, witnesses

The clerk of any United States court for the district wherein testimony is to be taken for use in any contested case in the Patent Office, shall, upon the application of any party thereto, issue a subpoena for any witness residing or being within such district, commanding him to appear and testify before an officer in such district authorized to take depositions and affidavits, at the time and place stated in the subpoena. *The provisions of the Federal Rules of Civil Procedure relating to the attendance of witnesses and to the production of documents and things shall apply to contested cases in the Patent Office.*

Every witness subpoenaed and in attendance shall be allowed the fees and traveling expenses allowed to witnesses attending the United States district courts.

A judge of a court whose clerk issued a subpoena may enforce obedience to the process or punish disobedience as in other like cases, on proof that a witness, served with such subpoena, neglected or refused to appear or to testify. No witness shall be deemed guilty of contempt for disobeying such subpoena unless his fees and traveling expenses in going to, and returning from, and one day's attendance at the place of examination, are paid or tendered him at the time of the service of the subpoena; nor for refusing to disclose any secret matter except upon appropriate order of the court which issued the subpoena.

CHAPTER 13—REVIEW OF PATENT OFFICE DECISION

§ 141. Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. *A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant had filed notice of appeal according to section* 142 *of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section* 146 *of this title.* Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

§ 142. Notice of appeal

When an appeal is taken to the United States Court of Customs and Patent Appeals, *the appellant shall give*

notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

§ 144. Decision on appeal

The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and *the decision shall be confined to the points set forth in the reasons of appeal.* Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

§ 145. Civil action to obtain patent

An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, *have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia* if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and *such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law.* All the expenses of the proceedings shall be paid by the applicant.

§ 146. Civil action in case of interference

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question

of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

Federal Rule of Civil Procedure 30(b):

Rule 30. Depositions Upon Oral Examination

(b) Orders for the Protection of Parties and Deponents. After notice is served for taking a deposition by oral examination, *upon motion seasonably made by any party* or by the person to be examined and upon notice and for good cause shown, the *court in which the action is pending may make an order* that the deposition shall not be taken, or that it may be taken only at some designated place other than that stated in the notice, or that it may be taken only on written interrogatories, or *that certain matters shall not be inquired into,* or that the scope of the examination shall be limited to certain matters, or that the examination shall be held with no one present except the parties to the action and their officers or counsel, or that after being sealed the deposition shall be opened only by order of the court, or that secret processes, developments, or research need not be disclosed, or that the parties shall simultaneously file specified documents or information enclosed in sealed envelopes to be opened as directed by the court; or the court may make any other order which justice requires to protect the party or witness from annoyance, embarrassment, or oppression.

Title 37, Part 1, Code of Federal Regulations [Patent Office Rule 201(c)].

§ 1.201. Definition, when declared

* * * * *

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. *The parties shall make known any and all right, title and interest affecting the ownership of any application or pat-*

ent involved or essential to the proceedings, not recorded in the Patent Office when an interference is declared, *and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.*

APPENDIX B.

Opinion of the Court Below. This opinion is set forth as Appendix A (Ap. 1 to 18) in petitioners' petition No. 715.

Companion case.

ROBERT C. SWITZER and RICHARD A. WARD,

Plaintiffs,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Defendant.

Civ. A. No. 185-58.

United States District Court
District of Columbia,
March 31, 1960.

(183 Federal Supplement 467)

RICH, *Judge.**

This is an action pursuant to 35 U. S. C. § 145 asking the court to authorize the defendant to grant a patent to plaintiffs on their patent application, Ser. No. 484,319, filed January 26, 1955, entitled "Penetrant Inspection Methods of Flaw Detection."

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* Associate Judge, United States Court of Customs and Patent Appeals, sitting by designation.

The application in suit contains five claims copied from patent No. 2,667,070 issued to Sockman and Brady January 26, 1954, plaintiffs' claims 1-5 corresponding, respectively, to claims 4, 5, 6, 7, and 9 of that patent.

The Patent Office presents two issues to the court:

(1) That Canadian patent No. 490,080 which issued January 27, 1953 and corresponds to the U. S. Sockman *et al.* patent, is a statutory bar under 35 U. S. C. § 102(a) or (b).

(2) That no patent can issue to plaintiffs on the application in suit because it would constitute double patenting by reason of the issuance on June 24, 1958, of patent No. 2,839,918 to Robert C. Switzer.

(1) The statutory bar issue

[1] The resolution of this issue depends on whether the claims in suit are entitled to the filing date of a parent application, Ser. No. 606,708, filed July 23, 1945, by Ward and Switzer, of which the application in suit is a continuation-in-part. This question arises because the application in suit, which admittedly supports the claims, contains a page of disclosure (page 19) additional to what is contained in application Serial No. 606,708. Plaintiffs assert and defendant denies that the "entire page was added in the present application to point out how the seven examples (which are common to the two applications) do inherently support the claim language." Further consideration of this issue of inherency, if that is the issue, requires an understanding of the subject matter claimed.

The invention is a method of detecting surface flaws in bodies such, for example, as machine parts and involves coating the body with a dye-containing penetrant which gets into the flaws, wiping the penetrant off of the surface, depositing on the surface a so-called developer such as a

suspension of talc in alcohol, letting the alcohol evaporate to leave a white absorbent film on the surface and then watching for spots of color to develop. This will happen if there has been a flaw in which some of the penetrant was trapped because the talc will absorb it and become colored by the dissolved dye, thus revealing the flaw. Plaintiffs' claim 1, which is claim 4 of the Sockman *et al.* patent, reads as follows:

> "The method of inspecting a part for surface defects which comprises applying to a surface of said part a solution of a dye in a penetrant liquid consisting of a volatile liquid and a relatively non-violatile liquid having a higher surface tension than said volatile liquid, said relatively non-volatile liquid consisting essentially of an oxygen-containing organic liquid, removing penetrant liquid from the surface to permit evaporation of part of the volatile liquid from the penetrant liquid remaining in the defect whereby there is an increase in the surface tension of the liquid in said defect, and depositing on said surface a layer of finely divided penetrant liquid absorbing material of a color contrasting with that of said dye whereby penetrant liquid will be absorbed in said deposit to form a visible trace."

The issue here is whether this and the other similar but more limited claims are supported by the specification of the 1945 application, Serial No. 606,708. In other words, are they supported without recourse to the matter added in the application at bar? If the parent case disclosure supports the claims, then plaintiffs are entitled to its 1945 filing date and the Sockman *et al.* Canadian patent issued in 1953, which is the sole reference on this issue, is not a statutory bar.

The novelty of the instant invention lies not in the manipulative steps of the process but in the claimed composition of the penetrant liquid, both the steps per se and

the use of "developers" being known. The penetrant liquid, as the above claim shows, is a three-component liquid. It consists of a volatile liquid, a relatively non-volatile liquid, and a dye. The non-volatile liquid must have a higher surface tension than the volatile liquid and consist essentially of an oxygen-containing organic liquid. When such a penetrant liquid is left in a surface defect such as a crack, the more volatile liquid tends to evaporate at the surface, leaving a higher proportion of the less volatile component which increases the surface tension of the penetrant. This appears to promote exudation of the penetrant from the flaw and its absorption by the developer reveals the flaw, in a known manner, through the coloration of the developer residue by the dye.

To further develop the issue, the most specific definition of the penetrant is that contained in claim 3 (Sockman *et al.* claim 6) which includes the following:

> "* * * a solution of a dye in a penetrant liquid consisting of 50% to 75% volatile portion having a relatively low surface tension as compared to dibutyl phthalate and from 50% to 25% of a relatively non-volatile portion consisting essentially of an oxygen-containing organic liquid having a higher surface tension than said volatile portion * * *."

Compared to claim 1, it will be observed that claim 3 is more specific in calling for percentages of volatile and non-volatile portions of the liquid and in relating the surface tension of the volatile portion to that of dibutyl phthalate, a compound used by Sockman *et al.* but not mentioned in plaintiffs' 1945 application. At the same time the language is different in that claim 1 refers to a penetrant liquid consisting of a volatile and a non-volatile *liquid,* whereas claim 3 refers to the volatile and non-volatile *portions* of the penetrant liquid. In this particular,

claim 2 is like claim 1 and claims 4 and 5 are like claim 3. I mention this difference in connection with a point made by the board that under plaintiffs' claims the second liquid component "*must be liquid* prior to compounding the penetrant liquid which includes both liquids." [Emphasis mine.] Certainly there is no such requirement to be found in claims 3, 4, and 5. As plaintiffs have pointed out, the claims do not call for oxygen-containing organic *compounds* and a *liquid* meeting the claim limitations could consist of a solid compound dissolved in a solvent. Nor do I see that claims 1 and 2 which call for a "relatively nonvolatile liquid consisting essentially of an oxygen-containing organic liquid" impose any such requirement. This is a minor matter, however, in view of the main issue in this phase of the case, the disposition of which renders it unimportant. But it is necessary to know that the board did take that position on the construction of the claim language.

A great deal of confusion seems to have been engendered in the prosecution of the application in suit by an apparent asumption on the part of the Patent Office that the applicants were relying on page 19 of the instant application, which was added to the disclosure of the 1945 parent application and about which questions arose as to whether it was "new matter." An interference was declared with the Sockman and Brady U. S. patent No. 2,667,070 which is the counterpart of the Canadian patent asserted as an alleged statutory bar. Sockman et al. moved to dissolve and the primary examiner granted the motion on the ground that applicants could not rely on the 1945 application and hence Sockman et al. foreign patents issued more than a year before the filing of the instant application were statutory bars, making the counts unpatentable to the applicants. The examiner stated that the

added matter on page 19 "forms the basis for the proposed counts for interference as set forth in claims 1 to 5 of this case." In the *ex parte* prosecution following dissolution of the interference the applicants were in the position of trying to persuade the examiner to reverse the decision made in the interference that they were not entitled to the 1945 filing date. Naturally, he declined to do so. He reiterated that his reasons had been stated in the interference but in his "Final" action he undertook to summarize their "salient features." I quote them to show some of the errors in his thinking. He said:

> "The phrase 'oxygen-containing liquid[']' warrants emphasis as it is the crux of the claim. The phrase does not refer to a trace of oxygen such as air that may be found in water, or in bubbles that may be found in oils, but it refers to oxygen as an ingredient of the compound. There is *no statement* in the Ward et al. parent case Serial No. 606,708 that the ingredients added to the penetrant oil are oxygen containing. Furthermore the parent case Serial No. 606,708 *fails to teach the fact* that the ingredients are relatively non-volatile and consist essentially of an oxygen containing compound. While some of the emulsifying agents of the parent case may *inadvertently* contain oxygen, they do not '*consist essentially* of an oxygen containing liquid' as called for in the instant claims. The term 'consisting' is limitative and excludes other ingredients Ex parte Rawles 390 O.G. 707." [My emphasis except the last.]

This was in reply to the contention that the seven examples of penetrant liquids in the parent case, which are identical with the seven examples in the instant application, met the terms of the copied claims. The question was, and is, whether they do in fact, not whether the specification *said* that an oxygen-containing liquid contained oxygen, or *taught* that a relatively non-volatile liquid was relatively

non-volatile. What is meant by "inadvertently" containing oxygen is not clear. Oxygen-containing compounds do not contain their oxygen inadvertently.

On appeal to the Board of Appeals the applicants met with similar reasoning. After briefly reviewing the nature of the disclosure of the parent application, the board said:

> "There is no reference to be found in the earlier application, Serial No. 606,708 to the relatively [sic] volatility of the components of the testing agents or a recognition that the invention must include a second liquid, * * * or that the penetrant liquid is removed from the surface to permit evaporation of part of the volatile liquid. Clearly nothing is found in the earlier application to support the specific limitation in claim 3 that the 'volatile portion' has a relatively low surface tension as compared to dibutyl-phthalate as called for in that claim. * * * All these limitations are *mentioned for the first time* on page 19 of the specification of the present application. [My emphasis.]
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> * * * * *
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> "* * * there is nothing in the earlier application to indicate that in order to obtain the composition covered by the claims, the differences in volatility and other limitations as set out in the claims be observed, and *the fact that some of the examples might be construed as falling within their terminology is not sufficient.*" [My emphasis.]

The only authority cited by the board at that point was *In re Frevert et al.*, 119 F. 2d 437, 440, 28 CCPA 1128. That was an appeal from the refusal of a reissue patent and is distinguishable on its facts. Being for a reissue, it also involved different law, it being necessary that the reissue claims be for the same invention as that originally claimed. The court held that what was claimed "was not only not disclosed in appellants' patent, but obviously was not intended to be claimed therein." The only question we have

here is whether the subject matter of claims 1-5 is or is not disclosed in the 1954 parent case. We are not concerned with what the applicants then intended to claim. This has nothing to do, furthermore, with what is on page 19 of the application in suit. The place we have to look is in the specification of the parent case, Serial No. 606,708.

The position of the board, which it made doubly clear in a second opinion on a petition for reconsideration, was that the applicants' claims do not read on their parent case because (1) the second liquid component of the penetrant liquid must be a liquid prior to compounding and (2), in the board's own words, "It is obvious that all the emulsifying agents disclosed by appellants in the parent case are not liquids." Does this mean not all are liquids or none are liquids? First, to clear up the ambiguity, the board later explained that it meant the *majority* are solids. Secondly, to explain the significance of the applicants' "emulsifying agents," to which the board referred, it is as follows.

As applicants conceived their invention in 1945, with respect to the embodiments pertinent here, their testing agents were water-emulsifiable compositions that could be wiped on parts to be tested for flaws and washed off with water, leaving some penetrant, of course, in the flaws to show them up when a developer was applied. Such materials they made from "a water-insoluble oil or like liquid; it may be a single petroleum or hydrocarbon fraction or a number of them proportioned to give the penetrant good metal wetting characteristics, low surface tension, low volatility, suitable viscosity, and proper solvent power for the other constituents." There is no dispute over this ingredient, which corresponds to the *volatile* liquid or portion of the claims in suit. What I have just quoted is common to the application in suit and the parent specification. The second ingredient is the coloring material and there

is no dispute about support for it. The third ingredient is the emulsifying agent and the parent specification describes it thus:

> "The emulsifying agent is usually composed of one or more oil-soluble soaps, detergents, or other surface-tension reducing agents which render the testing agent 'self-emulsifying', that is, the testing agent will emulsify directly in water; in some instances it may be expedient to employ soaps or detergents which are not in themselves oil-soluble but which may be held in solution by a mutual solvent or coupling agent (often an alcohol) for the actual emulsifier and the oil; for the purposes of this invention, such mutual solvents or coupling agents may simply be considered a part of the emulsifying agent."

So much for the general description of emulsifying agents, but plaintiffs do not rely on this. They rely on seven specific examples which are thereafter set forth in the specification in which the emulsifiers are, by example number:

	Emulsifier	% by weight
1.	Naphthenic acid soap (molecular weight about 350)	16.7
2.	Octylaminoethanol soap of tetradecyl sulfuric acid	22.
3.	Tri (diethylene glycol ether) of sorbitol trioleate	2.
4.	Sodium salt of mahogany acid	50.
5.	Sodium dodecyl benzenesulfonate 18% and cyclohexanol 27%	45.
6.	Naphthenic acid soap	16.
7.	Refined sulfonated aromatic petroleum fractions (approximate empirical formula: C_{26} H_{25} SO_3 Na; approximate molecular weight: 430)	3.

At the trial in this suit, to refute the board's unsupported assertion that "all the emulsifying agents * * * are not liquids," plaintiffs put a chemist on the stand who described the foregoing agents, introduced samples of each, testified that each was a liquid, demonstrated that each was a liquid, stated their surface tensions and that each is organic and oxygen-containing. This testimony was not contradicted during the trial.[1] The six different liquids used as emulsifiers in the seven examples vary considerably in viscosity, from that of common mineral oil to the consistency of mayonnaise but clearly none is a solid and I hold that all are liquids by common as well as technical definitions of the term "liquid." One further observation is required with respect to the material in Example 5. Plaintiffs admit that the cyclohexanol in the cyclohexanol-sodium dodecylbenzene sulfonate solution is solid at room temperature. Nevertheless, the emulsifying *agent* as used is certainly a liquid and both of its constituents are organic, oxygen-containing compounds.

On the basis of the evidence I hold that the limitation of the appealed claims calling for an oxygen-containing organic liquid as a constituent of the penetrant liquid is fully supported in the parent specification Serial No. 606,708.

Adverting to the examiner's objection that there was no "statement" in application 606,708 that the ingredients are oxygen-containing, I note the fact that neither is there

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[1] The Patent Office Solicitor annexed to his brief photostats of two pages from chemical texts in support of his further instance that naphthenic acid soaps are solids, contrary to the testimony that those used by plaintiffs were liquids as shown by an exhibit in evidence. Plaintiffs, properly I think, object to this attempt to inject further evidentiary matter and have countered with an affidavit of the witness contradicting the solicitor's factual conclusions based on the texts. Such matters are improperly introduced after the close of the trial and I have ignored them.

any such statement in the Sockman et al. patent wherein the claims containing that limitation originated. All those patentees did was to disclose a group of organic compounds which *do* contain oxygen, give a single specific example of a penetrant liquid containing ethylene glycol monobutyl ether and dibutyl phthalate, and then claim oxygen-containing organic liquids broadly as the relatively non-volatile portion. Plaintiffs' parent application disclosure is as adequate to support this claim limitation. Sockman et al. had the *concept* of using materials known in the plastics art as "plasticizers." Plaintiffs' corresponding ingredients were known to and used by them as "emulsifiers." But Sockman et al. having obtained broad claims including *all* organic oxygen-containing liquids, which read on the examples of plaintiffs' parent case, it seems clear to me that plaintiffs have every right to copy those claims and to contest the right of Sockman et al. to them, regardless of the different approaches which Sockman et al. and the plaintiffs made, according to their initial concepts of their inventions. The error of the Patent Office, it seems to me, was in looking to the conceptual approaches of the rival inventors rather than the concrete end results.

As to the relative volatility limitation of the claims, in each of the seven specific examples of plaintiffs' parent case the emulsifier or oxygen-containing organic liquid is less volatile than the penetrant oil. And the non-volatile liquid in each case has a higher surface tension than the volatile liquid. As to claim 3, wherein the surface tension of the volatile portion is low "as compared to dibutyl phthalate," this is a fact which either exists or does not exist with respect to any given material. All one needs to find in the parent case is a material meeting that specification. Plaintiffs' chemist witness established to my satis-

faction that the surface tension of each of the volatile liquids in plaintiffs' seven examples is "low as compared to dibutyl phthalate." The latter, he testified, has a surface tension of 37.1 dynes/cm^2 and the surface tensions of the volatile liquids ranged from a low of 29.0 to a high of 31.9.

The only remaining limitation to be checked out as disclosed in the parent case is the percentage relation of the volatile and non-volatile liquid portions of the penetrant liquid. Claim 2 calls for 50% to 75% of a volatile "liquid" with the balance non-volatile and claim 3 is similar except that the non-volatile "portion" is also specified as from 50% to 25%, which is another way of saying the same thing. No particular argument has been made about these proportions, but I find that they are met by Example 5 where the volatile, kerosene, is 53% and the non-volatile is the material specified above in the table in the amount of 45%, the balance being color. It is also substantially met by Example 4 which has 49% kerosene and 50% sodium salt of mahogany acid.

On issue (1), *supra*, I hold, on the basis of the foregoing findings, that plaintiffs are entitled to rely as to all of claims 1-5 on the filing date of application Serial No. 606,708 and that the Canadian patent to Sockman et al. is, therefore, not a statutory bar. The contrary decision of the Board of Appeals is inconsistent with the facts and contrary to law. The procedural law which governs here is as stated in *Esso Standard Oil Co. v. Sun Oil Co.*, 97 U. S. App. D. C. 154, 159, 229 F. 2d 37, 42;

> "Of course, if the decision of the Patent Office is not warranted on the evidence before it, or if the new evidence reaches the necessary standard, the District Court may rule as the totality of the evidence may require."

The positive evidence in this court in my judgment overcomes the erroneous speculations of the Patent Office Board of Appeals as to the controlling facts.

(2) Double Patenting

[2] This issue was sprung on the plaintiffs in this court at the opening of the trial. The issue being based on Patent No. 2,839,918 issued to the plaintiff Switzer, the situation was, as plaintiffs' counsel said, that he was surprised but not astonished. He was familiar with the circumstances but had no notice of the defense.[2]

In view of the nature of an action under 35 U. S. C. § 145, which asks the court to *authorize* the Commissioner of Patents to issue a patent, the defense was heard and permission given to amend the Answer to plead it. Knowing that a complete defense against granting a patent *may* exist, the court cannot conscientiously authorize the grant of a patent without looking into it. Nevertheless, the sporting theory of justice went out when the Federal Rules of Civil Procedure came in and it is only fair that the Patent Office should give notice to plaintiffs of such additional defenses as far ahead of trial as possible and at least as soon as it has been decided to present them. I recently had occasion to comment on a similar situation in *Harpman v. Watson,* D. C., 181 F. Supp. 919. Patent No. 2,839,-918 issued on June 24, 1958, six months after the complaint in this action was filed. It states that it, too, is a con-

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[2] Plaintiffs' counsel should be accustomed to double patenting defenses. The application for the very patent relied on was also involved in a suit under Sec. 145 in this Court and the Court of Appeals, the same attorneys representing the parties, and a double patenting issue was present. *Switzer v. Watson,* 102 U. S. App. D. C. 145, 251 F. 2d 386. The 1945 parent application went on an appeal to the C. C. P. A. with another double patenting issue. See *In re Ward and Switzer,* 236 F. 2d 428, 43 CCPA 1007.

/tinuation-in-part of the 1945 parent application, Serial No. 606,708. As of that date, presumably, the Patent Office was fully cognizant of the whole picture.

Since this defense arose in this court, there are no findings or decisions on it below. It would seem, in consequence, that no presumption of administrative correctness attaches to the contentions of the Patent Office Solicitor under the familiar *Abbott v. Coe*, 71 App. D. C. 195, 109 F. 2d 449, line of cases. Furthermore, the ruling of this court on double patenting depends only on the construction of legal documents, the prior Switzer patent relied on and the application in suit, and no question of Patent Office expertness is involved.

Patent No. 2,839,918 contains two claims, claim 1 reading:

> "In a method of detecting the presence of flaws in the surface layers of a metallic article, the steps comprising applying to the surface of said article a solution containing an oil and a coloring material, maintaining the solution in contact with the surface for a period of time of sufficient duration that the solution may penetrate said flaws, removing from the surface the solution which has not penetrated said flaws, and applying to the surface a finely divided absorbent material, the presence of flaws in the surface layers of said metallic article being visibly indicated by a coloring of the absorbent material lying adjacent said flaws by the coloring material contained in the solution upon the seeping of the latter out of said flaws onto the surface of the article."

Claim 2 differs in calling for "a penetrating oil and an oil soluble dye" instead of "an oil and a coloring material," in specifying "several minutes" as the time it is left on the surface, and in saying the color of the absorbent material contrasts with the color of the dye. (These two claims are

said to have been awarded to Switzer in an interference with Bloom et al. patent No. 2,420,646 and to have been copied from that patent.)

In urging that the allowance of the claims in suit would constitute "double patenting" the Patent Office puts great stress on the fact that the claims define processes in which the manipulative steps are the essential features. The similarity, if not the identity, of these steps is urged. This but obscures the true issue. Elsewhere, on the other issue, the board and the Patent Office Solicitor have both emphasized the fact that, quoting the board, "the novelty of the present invention resides in the particular composition of the penetrant liquid." Looking to this aspect of the claims, it is clear that the claims in suit are directed to a quite different invention from the simple "solution containing an oil and a coloring material" or "solution containing a penetrating oil and an oil soluble dye" of Switzer patent No. 2,839,918, in that they define the specifically different invention described in claim 1 of the application (Sockman et al. claim 4) as "a solution of a dye in a penetrant liquid consisting of a volatile liquid and a relatively non-volatile liquid having a higher surface tension than said volatile liquid, said relatively nonvolatile liquid consisting essentially of an oxygen-containing organic liquid."

The Patent Office Solicitor has not pointed out why these are not distinct inventions capable of supporting two patents. He argues on this branch of the case that the Switzer patent relied on and the parent case, Serial No. 606,708, have identical disclosures and that the claims differ merely in scope and "cover" the same subject matter. To this there are several answers. What the claims "cover," in the sense of what would infringe them, is not the determining factor but rather what inventive concepts they define. If it is the Patent Office position that the

claims in suit here are for the *same invention* as claims 1 and 2 of the Switzer patent, there seems to be an inconsistency in issuing the patent and thereafter contending in this case, as has been done on issue (1) discussed above, that the claims (to what is *allegedly* the same invention) are not supported by the specification which is substantially identical with that of the issued patent. Finally, as plaintiffs point out, while the argument is that the claims are based on but one common specification, the two claims of the Switzer patent originated in and were copied from Bloom et al. patent No. 2,420,646 and the claims here originated in and were copied from Sockman et al. patent No. 2,667,070 and allowed therein over said Bloom et al. patent cited as a reference. That both sets of claims now find support in the disclosures of a common specification proves nothing. Specifications frequently disclose a plurality of inventions claimable in separate patents. In fact the parent specification under consideration clearly describes at least two distinct inventions under two separate headings, "Non-Emulsification Techniques" and "Emulsification Technique." The Switzer patent claims find support in the former, the claims in suit only in the latter, to which all of the specific examples discussed above are directed.

I hold that the claims in suit, if contained in an issued patent, would not constitute double patenting in view of the claims of Switzer patent No. 2,839,918.

I have thought it best to dispose of the double patenting issue by holding that this defense is lacking in merit, although plaintiffs' brief suggests that the amendment to the answer raising this defense, filed in accordance with permission granted at the trial, should be stricken. However, had my conclusion on this defense, on the evidence now in the record, gone against plaintiffs, I would have

felt that they were entitled to an opportunity to present other evidentiary matter alleged to exist to counter this defense, of which they had no notice prior to trial.

This opinion contains the court's findings of fact and conclusions of law. Plaintiffs may have judgment authorizing the Commissioner of Patents to issue a patent on claims 1-5, on compliance with the requirements of law. Submit order.